

## REMARKS

This Response is submitted in reply to the Office Action dated August 25, 2009. Claims 1 to 10 and 21 have each been amended for clarity. Claims 11 to 20 and 22 to 25 have been canceled without prejudice or disclaimer. No new matter has been added by these amendments.

A Petition for a One-Month Extension of Time and a Supplemental Information Disclosure Statement are submitted herewith. Please charge deposit account number 02-1818 for any fees which are due in connection with this Petition for a One-Month Extension of Time, this Supplemental Information Disclosure Statement and this Response.

The Office Action rejected Claims 1 to 4, 8, 10, 21 and 25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,997,400 to Seelig et al. ("Seelig") in view of Patent No. GB2372218 to Muzaffar et al. ("Muzaffar") and U.S. Patent No. 4,700,948 to Okada ("Okada"). Applicant respectfully disagrees and traverses this rejection for at least the following reasons.

The Abstract of Seelig discloses that:

[t]he gaming system of the present invention includes one or more slot machines associated with a racing display wherein the racing element or elements are not necessarily racing against each other. Rather, the racing element moves each time predetermined combination appears on the slot machine. A player is rewarded if his or her racing element reaches a predetermined position. While a clock may be included with each racing element racing against the clock, the racing elements may move independently of a clock. The racing display may be built directly into the slot machine so that the slot player can easily see the progress of his racing element. Alternatively, a large racing display may be utilized that displays a plurality of racing elements thereby giving the appearance that the racing elements are racing against each other. Even further, Win, Place and Show positions may be located adjacent a finish line and the slot player whose racing element reaches either of these positions is awarded a prize depending on the position reached.

Page 1 of Muzaffar discloses that:

[t]he present invention relates to the apparatus and method for playing a spot-the-difference competition or the like, particularly but not exclusively

on a broadcast-receiving device, e.g. television set-top box. The invention relates particularly but not exclusively to interactive TV systems.

[i]n a spot-the-difference competition an entrant compares at least two images which are generally similar but differ in at least one respect. The entrant uses his skill and judgment to determine the difference or differences. These images may be any visual depiction such as a photograph illustration or the like, and may be displayed on a television, video monitor or other display device.

The Office Action relied on Muzaffar for disclosing that the difference between the first amount of time and the second amount of time is greater than the elapsed time.

The Abstract of Okada discloses:

[a] slot machine having five rotatable reels, each bearing on its outer periphery symbols of at least twelve different playing cards consisting of at least three cards of each suit and four out of 20 different cards consisting of the aces, tens and face cards of a deck of playing cards, and with spot cards numbered two through nine. Combinations of cards are displayed in horizontal rows at random during each game, and prizes are awarded when prize-winning combinations of cards corresponding to specified hands suitable for melding in a poker game occur on prize-winning rows previously selected. For selectively discarding any of the cards of an occurring combination, the slot machine is provided with pushbuttons which restart the rotation of a selected reel or reels.

The Office Action relied on Okada for disclosing a first outcome based on a random number generator.

Amended independent Claim 1 is directed to a method of operating a gaming system including (a) causing at least one processor to execute a plurality of instructions to initiate a secondary game at a gaming device, a play of the secondary game being based on at least one outcome of a plurality of plays of a primary game; (b) at a first point in time, causing the at least one processor to execute the plurality of instructions to determine a first game situation of the secondary game, the first game situation including a first amount of time available for completing the secondary game; (c) causing the at least one processor to execute the plurality of instructions to randomly determine, based on a random number generator, a first outcome; (d) at a second, subsequent point in time, causing the at least one processor to execute the plurality of instructions to determine a second game situation of the secondary game, the second

game situation being based on the first game situation and the randomly determined first outcome, the second game situation including a second amount of time available for completing the secondary game, wherein a difference between the first amount of time available for completing the secondary game and the second amount of time available for completing the secondary game is different than an amount of elapsed time between the first point in time and the second point in time; and (e) when an amount of time available to complete the secondary game reaches a designated amount of time: (i) causing the at least one processor to execute the plurality of instructions to determine whether to provide any awards for any generated secondary game outcomes; and (ii) causing the at least one processor to execute the plurality of instructions to cause the secondary game to end.

Page 13 of the Office Action stated that:

[i]t would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the secondary game of Seelig with the time reduction method of Muzaffar and the random number generation method of Okada in order to encourage slot players to continue playing and to entertain both the players themselves and others who may be watching.

Additionally, page 22 of the Office Action stated that:

[i]n response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one skilled in the art to integrate the teachings of Okada and Muzaffar into the teachings of Seelig in order to encourage slot players to continue playing and to entertain both the players themselves and others who may be watching (Seelig, Col. 1-2, lines 66-4).

Applicant respectfully disagrees and submits that the Office Action ignores the warnings of KSR International Company v. Teleflex Inc., et al., (550 U.S. 398, 2007) that a "factfinder should be aware, of course, of the distortion caused by hindsight bias

and must be cautious of arguments reliant upon *ex post* reasoning." In this case, the Office Action is improperly modifying Muzaffar with the random number generation of Okada to reduce the time available to complete the game by an amount of time that is greater than the amount of time which has elapsed based on a random determination. After improperly modifying Muzaffar, the Office Action is improperly combining this modified Muzaffar with Seelig to piece together the method of previously presented independent Claim 1. Only with the benefit of improper hindsight reasoning is the Office Action modifying Muzaffar with the random number generation of Okada and then picking and choosing different elements from this modified Muzaffar and Seelig to recreate previously presented independent Claim 1 to form the basis of these rejections. Applicant submits that such reasoning is improper and thus these rejections are also improper.

Applicant submits that to modify Muzaffar to reduce the time available for completing a game by an amount of time that is greater than the amount of time which has elapsed based on one or more random determinations would render Muzaffar unsatisfactory for its intended purpose. In Muzaffar, the only outcomes that cause a reduction of time that is more than the time elapsed between a first time and a second time are: (i) a wrong answer by a player, and (ii) a player passing on a set of images (Muzaffar: pg. 3). Such outcomes of Muzaffar are not outcomes determined based on a random number, but rather are outcomes that are based on a player's skill. That is, Muzaffar does not contemplate reducing an amount of time randomly, because such a random penalty would run counter to the intended purpose of the skill game of Muzaffar and would render Muzaffar unsatisfactory for its intended purpose. Applicant submits that, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900,221 USPQ 1 125 (Fed. Cir. 1984); MPEP 2143.01(V). Accordingly, this modification to Muzaffar would render Muzaffar unsatisfactory for its intended purpose and is thus improper.

Additionally, Applicant reiterates the arguments relating to the rejection of Claims 1 to 4, 8 and 10 that were submitted in the Response to the Examiner's Answer filed November 17, 2008. More specifically, Applicant reiterates that it would not have been

obvious to one of ordinary skill in the art to combine the concept of Muzaffar (i.e., imposing a time penalty based on a player's skill) with the game of Seelig, regardless of whether a primary game result of Seelig was generated via a random number generator.

Moreover, Applicant submits that the Office Action's generic reasoning for motivation to combine the references is improper. Such a general reason of combining references "to encourage slot players to continue playing and to entertain both the players themselves and others who may be watching", results in nearly every reference in the gaming industry being combinable with nearly every other reference in the gaming industry. This is clearly not the case. In this case, it would not have been obvious to one of ordinary skill in the art at the time of the invention to combine the secondary game of Seelig with the time reduction method of Muzaffar and the random number generation method of Okada to result in the method of previously presented independent Claim 1. Applicant submits that only with the benefit of improper hindsight reconstruction is the Examiner picking and choosing different elements from Seelig, Muzaffar and Okada to recreate the claimed invention to form the basis of these rejections. For at least these reasons, Applicant submits that these rejections are improper and should be withdrawn.

Assuming, arguendo, that Seelig, Muzaffar and Okada are properly combinable, Applicant submits that neither Seelig, Muzaffar or Okada individually, nor the method of operating a gaming system resulting from the combination of Seelig, Muzaffar and Okada anticipate or render obvious determining a second game situation of a secondary game based on a first game situation and a randomly determined first outcome, the second game situation including a second amount of time available for completing the secondary game, wherein a difference between the first amount of time available for completing the secondary game and the second amount of time available for completing the secondary game is different than an amount of elapsed time between the first point in time and the second point in time.

On the other hand, the method of operating a gaming system of amended independent Claim 1 includes, amongst other elements, causing the at least one processor to execute the plurality of instructions to randomly determine, based on a

random number generator, a first outcome, and at a second, subsequent point in time, causing the at least one processor to execute the plurality of instructions to determine a second game situation of the secondary game, the second game situation being based on the first game situation and the randomly determined first outcome, the second game situation including a second amount of time available for completing the secondary game, wherein a difference between the first amount of time available for completing the secondary game and the second amount of time available for completing the secondary game is different than an amount of elapsed time between the first point in time and the second point in time.

Accordingly, Applicant submits that amended independent Claim 1 is patentably distinguished over Seelig, Muzaffar and Okada and is in condition for allowance.

Applicant submits that amended Claims 2 to 10 and 21 each depend directly or indirectly from amended independent Claim 1 and are also allowable for the reasons given with respect to amended independent Claim 1 and because of the additional features recited in these claims.

The Office Action rejected Claims 5 to 7 under 35 U.S.C. §103(a) as being unpatentable over Seelig in view of Muzaffar and Okada and in further view of U.S. Patent Application Publication No. 2001/0031654 to Walker et al. ("Walker"). Applicant respectfully disagrees and traverses this rejection for at least the following reasons.

Page 17 of the Office Action stated that:

[i]t would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the time-based secondary game of Seelig as modified by Muzaffar with the handle pull- and time-limited game of Walker in order to increase the play of the machine and the revenue for the casino.

As discussed above, the Office Action is improperly modifying Muzaffar with the random number generation of Okada to reduce the time available to complete the game by an amount of time that is greater than the amount of time which has elapsed based on a random determination. Such a combination is improper and any combination which is based on this improper combination is also improper and should be withdrawn.

As also discussed above, assuming, arguendo, that Seelig, Muzaffar and Okada are properly combinable, the method of operating a gaming system resulting from the combination of Seelig, Muzaffar and Okada does not anticipate or render obvious determining a second game situation of a secondary game based on a first game situation and a randomly determined first outcome, the second game situation including a second amount of time available for completing the secondary game, wherein a difference between the first amount of time available for completing the secondary game and the second amount of time available for completing the secondary game is different than an amount of elapsed time between the first point in time and the second point in time. Walker does not cure this deficiency.

Accordingly, regardless of whether or not Walker anticipates an amount of time available for completing a first number of handle pulls, the method of operating a gaming system resulting from the combination of Seelig, Muzaffar, Okada and Walker does not anticipate or render obvious (without improper hindsight reconstruction) determining a second game situation of a secondary game based on a first game situation and a randomly determined first outcome, the second game situation including a second amount of time available for completing the secondary game, wherein a difference between the first amount of time available for completing the secondary game and the second amount of time available for completing the secondary game is different than an amount of elapsed time between the first point in time and the second point in time.

On the other hand, the method of operating a gaming system of each of amended Claims 5 to 7 includes, amongst other elements, causing the at least one processor to execute the plurality of instructions to randomly determine, based on a random number generator, a first outcome, and at a second, subsequent point in time, causing the at least one processor to execute the plurality of instructions to determine a second game situation of the secondary game, the second game situation being based on the first game situation and the randomly determined first outcome, the second game situation including a second amount of time available for completing the secondary game, wherein a difference between the first amount of time available for completing the secondary game and the second amount of time available for completing the secondary game, and the second amount of time available for completing the secondary game.

secondary game is different than an amount of elapsed time between the first point in time and the second point in time.

For at least these reasons, Applicant submits that amended Claims 5 to 7 are each patentably distinguished over Seelig, Muzaffar, Okada and Walker and are in condition for allowance.

The Office Action rejected Claim 9 under 35 U.S.C. §103(a) as being unpatentable over Seelig in view of Muzaffar and Okada and in further view of U.S. Patent No. 6,368,216 to Hedrick et al. ("Hedrick"). Applicant respectfully disagrees and traverses this rejection for at least the following reasons.

Page 17 of the Office Action stated that:

[i]t would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the time-based secondary game of Seelig as modified by Muzaffar with the symbol collection game of Hedrick in order to encourage slot players to continue playing and to entertain both the players themselves and others who may be watching.

As discussed above, the Office Action is improperly modifying Muzaffar with the random number generation of Okada to reduce the time available to complete the game by an amount of time that is greater than the amount of time which has elapsed based on a random determination. Such a combination is improper and any combination which is based on this improper combination is also improper and should be withdrawn.

As also discussed above, assuming, arguendo, that Seelig, Muzaffar and Okada are properly combinable, the method of operating a gaming system resulting from the combination of Seelig, Muzaffar and Okada does not anticipate or render obvious determining a second game situation of a secondary game based on a first game situation and a randomly determined first outcome, the second game situation including a second amount of time available for completing the secondary game, wherein a difference between the first amount of time available for completing the secondary game and the second amount of time available for completing the secondary game is different than an amount of elapsed time between the first point in time and the second point in time. Hedrick does not cure this deficiency.

Accordingly, regardless of whether or not Hendrick anticipates an amount of time available to obtain a target number of game indicia, the method of operating a gaming system resulting from the combination of Seelig, Muzaffar, Okada and Hendrick does not anticipate or render obvious (without improper hindsight reconstruction) determining a second game situation of a secondary game based on a first game situation and a randomly determined first outcome, the second game situation including a second amount of time available for completing the secondary game, wherein a difference between the first amount of time available for completing the secondary game and the second amount of time available for completing the secondary game is different than an amount of elapsed time between the first point in time and the second point in time.

On the other hand, the method of operating a gaming system of amended Claim 9, includes, amongst other elements, causing the at least one processor to execute the plurality of instructions to randomly determine, based on a random number generator, a first outcome, and at a second, subsequent point in time, causing the at least one processor to execute the plurality of instructions to determine a second game situation of the secondary game, the second game situation being based on the first game situation and the randomly determined first outcome, the second game situation including a second amount of time available for completing the secondary game, wherein a difference between the first amount of time available for completing the secondary game and the second amount of time available for completing the secondary game is different than an amount of elapsed time between the first point in time and the second point in time.

For at least these reasons, Applicant submits that amended Claim 9 is patentably distinguished over Seelig, Muzaffar, Okada and Hendrick and is in condition for allowance.

The Office Action rejected Claims 13 and 17 to 19 under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent Applicant Publication No. 2002/0016200 to Baerlocher et al ("Baerlocher I"). Applicant submits that the cancellation of Claims 11 to 20 and 22 to 25 render this rejection moot.

The Office Action rejected Claims 11 to 12 under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,733,389 to Webb et al ("Webb"). Applicant submits that the cancellation of Claims 11 to 20 and 22 to 25 render this rejection moot.

The Office Action rejected Claims 13 to 19 under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,602,136 to Baerlocher et al ("Baerlocher II"). Applicant submits that the cancellation of Claims 11 to 20 and 22 to 25 render this rejection moot.

The Office Action rejected Claim 20 under 35 U.S.C. §103(a) as being unpatentable over Baerlocher I in view of Hedrick. Applicant submits that the cancellation of Claims 11 to 20 and 22 to 25 render this rejection moot.

The Office Action rejected Claim 22 under 35 U.S.C. §103(a) as being unpatentable over Webb in view of Seelig. Applicant submits that the cancellation of Claims 11 to 20 and 22 to 25 render this rejection moot.

The Office Action rejected Claim 23 to 24 under 35 U.S.C. §103(a) as being unpatentable over Baerlocher II in view of Seelig. Applicant submits that the cancellation of Claims 11 to 20 and 22 to 25 render this rejection moot.

An earnest endeavor has been made to place this application in condition for allowance and is courteously solicited. If the Examiner has any questions related to this Response, Applicant requests that the Examiner contact the undersigned.

Respectfully submitted,

K&L Gates LLP

BY MA

Holby M. Abern  
Reg. No. 47,372  
Customer No. 29159

Dated: December 23, 2009